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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD O. RATZEL and JAMES A. SIMMONS

Appeal No. 97-3703
Application No. 08/110,349¹

ON BRIEF

Before CALVERT, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 6 through 14, 16 through 18 and 26. Claims 19 through 25, the only other claims remaining

¹ Application for patent filed August 20, 1993. According to the appellants, this application is a continuation-in-part of Application 08/066,337, filed May 21, 1993, now abandoned; which is a continuation of Application 07/840,306, filed February 24, 1992, now abandoned; which is a divisional of Application 07/712,203, filed June 7, 1991, now U.S. Pat. No. 5,123,889; which is a continuation-in-part of Application 07/592,572, filed October 5, 1990, now U.S. Pat. No. 5,322,477.

in the application, have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

We REVERSE, enter a new rejection pursuant to the provisions of 37 CFR § 1.196(b) and REMAND.

BACKGROUND

The appellants' invention relates to a cushioning conversion machine for converting sheet-like stock material into cut sections of cushioning dunnage product including a cutting assembly and an automatic alignment device. An understanding of the invention can be derived from a reading of exemplary claim 1, a substantially correct copy of which appears in the appendix to the examiner's answer.²

The references of record relied upon by the examiner in rejecting the appealed claims are:

Walker
1959

2,882,802

Apr. 21,

² The copy of claim 1 in the appendix to the answer contains three errors with respect to the actual claim of record. In line 11, "coact" should be "coacts" and, in line 16, "rectilinear" and "together" should immediately precede and follow "motion," respectively.

Scott et al. (Scott) 1961	2,973,678	Mar. 7,
Giordano 1966	3,260,145	Jul. 12,
Ottaviano 9, 1980	4,237,776	Dec.
Armington et al. (Armington) 23, 1992	5,123,889	Jun.
Osmera (Swiss patent document) ³	477,252	Oct. 15, 1969

The following rejections are before us for review.

1. Claims 1 through 4, 9, 10 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of Scott and Osmera.
2. Claims 6 through 8, 11 through 14, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of Scott and Osmera, as applied above, and further in view of the appellants' admitted prior art shown in Figures 6 through 7D2 of the application.
3. Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ottaviano in view of Scott and Giordano.

³ An English language translation of this reference, prepared by the Patent and Trademark Office (PTO), is appended hereto.

4. Claims 1 through 4, 6 through 14 and 16 through 18 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of the Armington patent in view of Scott, Walker and Osmera.

5. Claim 26 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of the Armington patent in view of Scott, Walker and Giordano.

The complete text of the examiner's rejections and response to the argument presented by the appellants appears in the final rejection (Paper No. 16, mailed December 12, 1995) and answer (Paper No. 26, mailed April 11, 1997), while the complete statement of the appellants' argument can be found in the brief (Paper No. 25, filed December 16, 1996) and reply brief (Paper No. 27, filed June 13, 1997).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

examiner. As a consequence of our review, we make the determinations which follow.

Rejection 1

The examiner contends that Walker discloses the invention as claimed except for the automatic alignment device (final rejection, page 3) and the appellants do not challenge this contention. The examiner argues that

Scott teaches the use of such device (comprising an alignment member 25 and interconnecting members 37, 38, 29) for the purpose of supporting a work piece during a cutting operation without crushing the work piece. In view of Scott, it would have been obvious to one having ordinary skill in the art to provide Walker's device with an automatic alignment device in order to provide proper support of a work piece without crushing the work piece during a cutting operation [final rejection, page 3].

In the alternative, the examiner argues that it would have been obvious to provide the Walker device with a support and alignment table as suggested by Scott for the reasons discussed above and, further:

[Scott] teaches in figure 2, and column 4, line 75 through column 5, line 3, support **25**, which serves as a guide to allow the cut workpiece to be aligned and positioned on transfer table **43**, which stacks the workpiece on second conveyor **15**. Support 25 is

moved downward as the movable blade moves into [its] cutting engagement with the stationary blade. This movement prevents the workpiece from being crushed during cutting. As the cutting blade moves into [its] rest position, the support **25** likewise returns to [its] upper limit of movement, which allows the workpiece to be pushed along the surface of support **25** into engagement with transfer table **43**, after the cutting has taken place. It would have been obvious to one of ordinary skill to have provided Walker with a support and alignment table as taught by [Scott], in order to prevent damage to the workpiece due to misalignment with the next structure in the device [answer, pages 4 and 5].

The examiner relies on Osmera for its teaching to couple a holding device with a movable shear for rectilinear movement therewith and concludes that it would have been obvious, in view of this teaching, to couple an alignment device to Walker's movable blade for rectilinear movement in order to provide support for the wadding during a cutting operation without crushing and tilting the wadding (final rejection, page 3).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d

413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Having reviewed the combined teachings of Walker, Scott and Osmera, we do not agree with the examiner that these teachings would have suggested to one of ordinary skill in the art the modification proposed by the examiner.

Initially, Walker does not disclose any support for the web of packing material downstream of the stationary base knife (23) but, rather, lets the severed material fall into a suitable receptacle, such as a container (28). See Figure 2 and column 3, lines 51 and 52. The movable shear pan (25) of Scott is provided specifically to guide and transfer the severed gelatin material from the first conveyor (11) to a transfer table (43), which then pivots the severed material to an upright orientation onto the second, slower conveyor (15) for further drying. It is designed to move resiliently

downwardly during the cutting operation to prevent the material from being crushed (column 3, lines 68 to 72). As Walker permits the severed material to simply drop into a container below the cutting area and does not disclose any further processing or work station, aligned with the outlet of the conversion machine, to which the severed material is transferred, there is no need for a transfer/alignment device or anti-crushing mechanism such as the shear pan (25) of Scott on the Walker device. Accordingly, the teachings of Walker and Scott would not have suggested to one of ordinary skill in the art provision of such a device on the Walker apparatus.

As for Osmera, even if its teachings were combined with Walker to provide a holding or support device to clamp the web of packing material emitted from the Walker conversion machine against the movable knife (20) during the cutting, such a combination would not suggest "an automatic alignment device which automatically aligns the cut section with the outlet opening when said second blade is moved from said cutting position to said rest position" as required by claim 1. Specifically, Osmera teaches providing an air chamber for reducing the speed of the upward return movement of the

holding-down device (2) relative to that of the blade (10), so that the sheared-off segment is released, as shown in Figure 2, to tilt and slide away from the cutting area before the holding-down device (2) returns to its upper-most position shown in Figure 1 (see pages 5 to 7 of the translation prepared by the PTO). Thus, even if such a holding-down device were employed on Walker to clamp the web during cutting, such a device would not align the cut section with the outlet opening of the conversion machine. Rather, Osmera teaches having the device release the cut section and permit it to fall into the container (28) without reaching an aligned condition.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1 through 4, 9, 10 and 16 under 35 U.S.C. § 103.

Rejection 2

We have reviewed the teachings of the appellants' admitted prior art shown in Figures 6 through 7D2 of the application explicitly relied upon by the examiner (the post-cutting constraining assembly, the outlet opening and the cutter assembly) on pages 4 and 5 of the final rejection, but

find nothing therein which overcomes the deficiencies of the combination of Walker, Scott and Osmera discussed above.

Accordingly, we also cannot sustain the examiner's rejection of claims 6 through 8, 11 through 14, 17 and 18 under 35

U.S.C. § 103.

Rejection 3

Ottaviano discloses a cushioning dunnage producing and handling apparatus comprising a cutting mechanism, shown in Figure 7, including a stationary cutter edge (78b) and a movable cutter blade (78a) driven by a double acting fluid motor (89). A supporting table surface (96) helps support the dunnage as it is emitted from the device. A mobile transfer vehicle (102) comprising a rotatable shaft (110) equipped with a U-shaped bracket (112) for securing the leading edge of the dunnage strip to the shaft is located near the outlet of the dunnage machine for collecting dunnage onto a roll and moving it to a selected area which may be remote from the dunnage machine (column 7, lines 5 through 25).

As the Ottaviano cutter blade (78a) moves upwardly, in a direction away from the table surface (96), to coact with the stationary cutter edge (78b) during cutting, there is no risk

of crushing the dunnage between the blade and the table surface during cutting. Further, as the dunnage strip is conveyed away from the dunnage machine by being wound on the rotating shaft (110) of the transfer vehicle, alignment of the trailing edge of the severed strip with the outlet of the dunnage machine is not critical. Therefore, we see no reason why one of ordinary skill in the art would have been motivated to provide an alignment or anti-crushing mechanism of the type taught by Scott on the Ottaviano device.

We have also reviewed the teachings of Giordano but find nothing therein which would overcome the deficiencies of the combination of Ottaviano and Scott discussed above. Accordingly, we cannot sustain the examiner's rejection of claim 26 under 35 U.S.C. § 103.

Double Patenting Rejections

"Obviousness-type" double patenting is a judicially created doctrine that prevents an unjustified extension of the patent right beyond the statutory limit. It precludes issuance of a second patent when the claimed subject matter is not patentably distinct from the subject matter claimed in a

commonly owned patent when the issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by the patent. In order to overcome an "obviousness-type" double patenting rejection, an applicant may file a "terminal disclaimer" foregoing that portion of the term of the second patent that extends beyond the term of the first. See In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). The examiner contends that the claims on appeal are obvious variants of claims 1 and 15 of the Armington patent and that, accordingly, issuance of a patent on the claimed subject matter, without a terminal disclaimer, would provide an unjustified extension of the term of the right to exclude already granted by the Armington patent.

Claims 1 and 15 of the Armington patent recite, in summary, a cushioning dunnage conversion machine comprising a frame, a forming assembly, a stock supply assembly, a pulling/connecting assembly, and a cutting assembly and the subcombination of a cutting assembly for the cushioning dunnage machine, respectively. Both of these patent claims differ from the claims on appeal in that, *inter alia*, neither

patent claim recites an alignment device for aligning the cut dunnage section with the outlet opening of the cushioning dunnage conversion machine. We also note that neither patent claim 1 nor patent claim 15 recites any structure for supporting the dunnage during cutting or any apparatus downstream of the cutting assembly, such as a further processing station or conveyor or a post-cutting constraining assembly. As discussed above, the shear pan of Scott is used to help guide and transfer product between a first conveyor and a second conveyor. Accordingly, in our opinion, Scott would not have suggested to one of ordinary skill in the art provision of a transfer/alignment or anti-crushing device of the type disclosed therein on the apparatus recited in patent claim 1 or patent claim 15.

We have also reviewed the teachings of Walker, Osmera and Giordano but find nothing therein which would overcome the above-mentioned deficiency. Accordingly, we cannot conclude, on the basis of the teachings of the applied references, that the claims on appeal are directed to obvious variants of the subject matter of patent claims 1 and 15.

Therefore, we are constrained to reverse the examiner's obviousness-type double patenting rejections of claims 1 through 4, 6 through 14, 16 through 18 and 26.

NEW REJECTION UNDER 37 CFR § 1.196(b)

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of the appellants' admitted prior art shown in Figures 6 through 7D2 and discussed on page 16, line 15, to page 20, line 24, of the application.⁴

Walker discloses a machine for converting continuous webs of sheet material into crumpled lengths of packing material comprising a frame (1), embossing rolls (41,42), funnel (6) and rollers (9,10) for converting the sheet material into the crumpled packing material and a cutting assembly including a first knife (23) and a second knife (20) movable in a rectilinear motion (note Figure 3) between a rest position and a cutting position in shearing engagement with the first knife (23). Walker does not disclose an automatic alignment device

⁴ The appellants admitted this subject matter is prior art to this application on page 2 of Paper No. 17, filed April 10, 1996.

which aligns the cut section with an outlet opening of the machine when the second knife (20) is moved from the cutting position to the rest position. However, the appellants' admitted prior art teaches a post-cutting handling apparatus, for use with a cushioning dunnage conversion machine, comprising a post-cutting constraining assembly (58) located downstream of the cutting assembly in alignment with an outlet opening (48) and an alignment member (202') coupled by a link (204') to the moving blade (162') of the cutting assembly for motion therewith for re-aligning the cut section (32) with the outlet opening during movement of the blade (162') from the cutting position to the rest position to

[insure] a smooth transition for the cut section 32 from the outlet opening 48 into the post-[cutting] constraining assembly 58. In this manner, the cut section 32 steadily continues its downstream travel as it is pushed by the approaching coined strip 30 [specification, page 19].

To have provided the post-cutting handling assembly taught by the appellants' admitted prior art on the Walker conversion machine (by providing a post-cutting constraining assembly aligned with an outlet opening of the conversion machine and an alignment device coupled to the movable knife

20 for motion therewith) to achieve the above-noted advantages would have been obvious.

While the alignment member disclosed by the appellants' admitted prior art is mounted to the frame so as to pivot into and out of alignment with the bottom of the outlet opening and thus does not move rectilinearly as claimed, whether the alignment member is mounted in the Walker machine so as to travel in a curvilinear path about a fixed pivot point or in a rectilinear path into and out of alignment with the outlet opening is considered to be an obvious matter of design choice. One of ordinary skill in the art would have understood that the particular path traveled by the alignment member is immaterial, as long as the alignment member is aligned with the outlet opening in its upper-most position and, further, would have understood how to mount the alignment member for travel in any desired path. Where a change solves no stated problem, it is considered to be a mere matter of design choice and therefore obvious. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

REMAND TO THE EXAMINER

The application is remanded to the examiner to consider, on the record, whether claims 2 through 4, 6 through 14, 16 through 18 and 26 are unpatentable under 35 U.S.C. § 103 over the appellants' admitted prior art, as applied in the new ground of rejection set forth above, in combination with Walker and/or any other prior art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 4, 6 through 14, 16 through 18 and 26 under 35 U.S.C. § 103 and under the judicially created doctrine of obviousness-type double patenting is reversed. A new rejection of claim 1 under 35 U.S.C. § 103 is added pursuant to the provisions of 37 CFR § 1.196(b). Additionally, the application is remanded to the examiner for consideration of the appellants' admitted prior art with regard to the remaining claims as discussed above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR § 1.196(e).

37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(e) provides that

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b) and REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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